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10/692,517

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Bernard J. Patsky

UTL 03-032

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08/30/2006

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,517

Applicant(s)

PATSKY, BERNARD J.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,6-16 and 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Duclos, Jessen and Kobayashi.

Ryan discloses a golf club with an alignment line which takes into account downward bowing of a shaft and a golfer's visual parallax error (abstract, Col. 1, Lns. 19-25, 29-35), sweet spot markings, a marking extending from a point at the intersection of the face surface and the top surface (Fig. 5), a reference line on a drawing showing non-corrected target lines and corrected lines (Figs. 2, 3, 5), and a bending correction being dependant on the composition of a shaft and the speed of a golfer's swing (Col. 3, Lns. 40-50). Ryan does not disclose have markings on a head for a non-corrected target marking but clearly an artisan skilled in assisting a golfer in aligning a club to a ball would have selected a suitable marking arrangement in which having both the non-corrected marking and a corrected marking as shown by the reference lines in figures 2-3 and 5 is included.

Ryan lacks a grip, balance point target line markings, a line extending from a point at the intersection of the face surface and the top surface, a line across a top surface ending at a point at the intersection of the top surface with the bottom surface, and an corrected alignment line with takes into account only a golfer's visual parallax error.

Duclos discloses corrected alignment markings to a sweet spot which only take into account a golfer's visual parallax error for a wood type club (Col. 1, Lns. 17-52, Col. 2, Lns. 3-5, Col. 3, Lns. 37-50, Col. 4, Lns. 14-35). In view of the patent of Duclos it would have been obvious to modify the club of Ryan to have a corrected alignment marking to a sweet spot which only takes into account a golfer's visual parallax error and not shaft bending in order to provide a club to a player with a swing strength which places very little or no bow on shaft either due to the stiffness of the shaft and/or the weakness of a player and in order to minimize the fitting process of a club to a player by only focusing on the visual error of a club and not the error induced by the bending of a shaft.

Jessen discloses a golf club having a grip (Fig. 2), an alignment marking (Ref. No. 15, Col. 2, Lns. 20-28) being in the form of a broad line on a top surface (Fig. 6) extending from a point at the intersection of the face surface and the top surface and a line on a head showing non-corrected target line (Fig. 6). In view of the patent of Jessen it would have been obvious to modify the golf club of Ryan to have a grip in order to minimize the vibrations felt by a player. In view of the patent of Jessen it would have been obvious to modify the golf club of Ryan to have lines on a top surface ending

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at a back end of a top surface showing a corrected target line in order to utilize a parallax corrected line instead of an arrow marking to assist a player in properly aiming a head who prefers a line while playing a round of golf.

Kobayashi discloses a head having a top surface intersection in a rear of a head with a bottom surface (Fig. 2) and center of gravity located behind a sweet spot such that a head is able to be balanced at the sweet spot (Col. 2, Lns. 44-53) in order to increase distance of flight of a ball with improved directing performance (Col. 2, Lns. 59-62). In view of the patent of Kobayashi it would have been obvious to modify the head of Ryan to have a top surface intersect with a bottom surface in order to use the advantages of parallax correction for an alignment of a club for a head which has a bottom surface which intersects with a top surface at a rear end. As such a line on a top surface would end at a point at the intersection of the top surface with the bottom surface. In view of the patent of Kobayashi it would have been obvious to modify the head of Ryan to have a center of gravity located behind a sweet spot such that the sweet spot is able to be a balance point in order to increase distance of flight of a ball with improved directing performance.

3. Claims 4-5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Duclos, Jessen, Kobayashi, and Elkins.

Ryan discloses a golf club with an alignment line which takes into account downward bowing of a shaft and a golfer's visual parallax error (abstract, Col. 1, Lns. 19-25, 29-35), sweet spot markings, a marking extending from a point at the intersection

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of the face surface and the top surface (Fig. 5), a reference line on a drawing showing non-corrected target lines and corrected lines (Figs. 2, 3, 5), and a bending correction being dependant on the composition of a shaft and the speed of a golfer's swing (Col. 3, Lns. 40-50).

Ryan lacks a grip, balance point target line markings, a line extending from a point at the intersection of the face surface and the top surface, lines on a head showing non-corrected target lines and corrected lines, an increased width line on a top surface ending at a point at the intersection of the top surface with the bottom surface, an corrected alignment line with takes into account only a golfer's visual parallax error, and a face line on a top surface a predetermined distance from the face.

Duclos discloses corrected alignment markings to a sweet spot which only take into account a golfer's visual parallax error for a wood type club (Col. 1, Lns. 17-52, Col. 2, Lns. 3-5, Col. 3, Lns. 37-50, Col. 4, Lns. 14-35). In view of the patent of Duclos it would have been obvious to modify the club of Ryan to have a corrected alignment marking to a sweet spot which only takes into account a golfer's visual parallax error and not shaft bending in order to provide a club to a player with a swing strength which places very little or no bow on shaft either due to the stiffness of the shaft and/or the weakness of a player and in order to minimize the fitting process of a club to a player by only focusing on the visual error of a club and not the error induced by the bending of a shaft.

Jessen discloses a golf club having a grip (Fig. 2), an alignment marking (Ref. No. 15, Col. 2, Lns. 20-28) being in the form of a broad line on a top surface (Fig. 6)

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extending from a point at the intersection of the face surface and the top surface and a line on a head showing non-corrected target line (Fig. 6). In view of the patent of Jessen it would have been obvious to modify the golf club of Ryan to have a grip in order to minimize the vibrations felt by a player. In view of the patent of Jessen it would have been obvious to modify the golf club of Ryan to have increased width lines on a top surface ending at a back end of a top surface showing a corrected target line in order to utilize a parallax corrected line instead of an arrow marking to assist a player in properly aiming a head who prefers a line while playing a round of golf.

Kobayashi discloses a head having a top surface intersection in a rear of a head with a bottom surface (Fig. 2) and center of gravity located behind a sweet spot such that a head is able to be balanced at the sweet spot (Col. 2, Lns. 44-53) in order to increase distance of flight of a ball with improved directing performance (Col. 2, Lns. 59-62). In view of the patent of Kobayashi it would have been obvious to modify the head of Ryan to have a top surface intersect with a bottom surface in order to use the advantages of parallax correction for an alignment of a club for a head which has a bottom surface which intersects with a top surface at a rear end. As such a line on a top surface would end at a point at the intersection of the top surface with the bottom surface. In view of the patent of Kobayashi it would have been obvious to modify the head of Ryan to have a center of gravity located behind a sweet spot such that the sweet spot is able to be a balance point in order to increase distance of flight of a ball with improved directing performance.

Jessen discloses a non-parallax corrected target line (Fig. 6). Ryan in view of Jessen would be obvious to disclose a parallax corrected target line. Ryan discloses a reference line on a drawing showing non-corrected target lines and corrected lines (Figs. 2, 3, 5). Elkins discloses a corrected target line (105) being together with an uncorrected target line (115-116) (Fig. 3) as well as corrected target lines (105b, 115a, 116a) being without any uncorrected target lines (Fig. 5). In view of the patents of Jessen and Elkins it would have been obvious to modify head of Ryan to have both lines on a head showing a non-corrected target line and a corrected target line in order to assist a teacher in showing a player or assist a golf club manufacturer in showing a potential golf club buyer how severe a ball is misaligned from a sweet spot by not having a parallax correction alignment marking and the need to have a parallax corrected alignment.

In addition, Elkins discloses a face line (150) in addition to a corrected target line (105) and non-corrected target lines (157-158) on a top surface a predetermined distance from the face (Fig. 6) in order to assist players who customarily used the front face to line up a club who now can use the face line (Col. 7, Lns. 4-22). In view of the patent of Elkins it would have been obvious to modify head of Ryan to have a face line on a top surface a predetermined distance from the face in order to assist players who customarily used the front face to line up a club.

With respect to claims 4-5 and 17, very little weight is given to the method steps of how the parallax corrected target line is made on the head since this is an apparatus claim and not a method claim. Weight is give to what an apparatus is and not how it is

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made. The club due to the combination of the teachings of Ryan in view of Duclos, Jessen and Kobayashi is the same product as that claimed in claims 4-5 and 17.

Response to Arguments

4. The argument that it is improper to use the reference of Ryan due to Ryan not mentioning a balance point is disagreed with. Ryan was not used to show this but Kobayashi was. Ryan clearly mentions a sweet spot and Kobayashi was used to show that it is known to make the sweet spot aligned with a center of gravity which makes the sweet spot a balance point. The argument that the reference of Ryan is improper due to Ryan not deriving a marking from a static condition is disagreed with. Ryan was not used to show this but Duclos was. Duclos derived a marking from a static condition taking into account only parallax error which is a static condition. The argument that none of the references disclose a face line is agreed with. As such the reference of Elkins has been added and this action is not made final. The applicants amendments to the claims were minor for claims 4-5 and 17 and did not necessitate a new grounds for rejection in that the claims as previously written required the sweet spot to be the balance point due to the method steps. The argument that it is improper to use the reference of Jessen due to Jessen does not disclosing the club is for actual play with a golf ball but in combination with a puck is disagreed with. Jessen clearly states that this apparatus is a club (Col. 2, Lns. 4-6) and a teaching of aligning and hitting a club with a puck is able to be equally used for aligning and hitting a golf ball since the whole

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purpose of this instruction device is to help teach a player to better hit a ball. The argument that it is improper to use the reference of Ryan due to Ryan not mentioning positioning a head at an angle of intended use or position of intended use to determine the location of the lines is disagreed with. These claims are apparatus claims and weight is given to what an apparatus is and not how it is made or used.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

26 August 2006



STEPHEN BLAU
PRIMARY EXAMINER